

Remarks

Applicant appreciates the Examiner's thorough examination of the present application.

Applicant appreciates the Examiner's withdraw of the rejections under 35 U.S.C. §102 based on Klassen and the rejections under 35 U.S.C. §103 based on Klassen in combination with the NL reference.

Applicant respectfully asserts that the claims presented herein overcome and are allowable over the rejections set forth in the Office Action. Application respectfully requests favorable reconsideration of the present application and the claims set forth herein.

Applicant appreciates the Examiner's consideration and allowance of claim 16 once amended in independent form. Applicant submits amended claim 16 which incorporates the limitations of claim 15 and claim 1. Should the Examiner have any further consideration with regard to claim 16 as amended herein, Applicant respectfully requests that the Examiner contact the undersigned attorney by telephone.

Rejections under 35 U.S.C. §102

Claims 1, 2, 4, 5, 7, 8, 10 have been rejected under 35 U.S.C. §102 based on the Cortese reference. Applicant respectfully asserts that the claims as amended herein overcome and are allowable over this rejection and respectfully requests favorable reconsideration of the present application in view of the amendments set forth herein, withdrawal of the rejection, and allowance of these claims.

The Cortese reference merely shows a porta filter as is commonly used with espresso machines. The porta filter has a cavity and a handle including portions which allow the porta filter to be attached to an espresso machine "head". The espresso head, it should be noted, is a component of the larger espresso machine and not a component of the porta filter (container).

While Cortese has a cover 66 of some sort, there is no structure or description which facilitates attachment or removal of the cover to the corresponding cup. Further, none of the other references supply a handle or other grip for attaching and removing the cover as set forth in the claims.

With regard to the rejection under 35 U.S.C. §102, it is well settled, anticipation requires “identity of invention.” *Glaverbel Societe Anonyme v. Northlake Manufacture Mktg. & Supply*, 33 USPQ2d 1496, 1498 (Fed. Cir. 1995). Each and every element recited in a claim must be found in a particular prior art reference and arranged as in the claims. *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978); *Lindemann Maschinenfabrik GMBH*, see *American Hoist and Derrick Company*, 221 USPQ481, 485 (Fed. Cir. 1984). Furthermore, in a rejection under 35 U.S.C. §102 (b) there must be no difference between what is claimed and what is disclosed in the applied reference. *In re Kalm*, 154 USPQ10, 12 (CCPA 1967); *Scripps v. Genentech Inc.*, 18 USPQ2d 1001,1010 (Fed. Cir. 1991).

As disclosed in the amended claims a cover is retained inside the cavity of the brewing substance container when attached thereto. The container or holder of the claims is removably detachable to the brewer. The amended claims incorporate a handle which is contained within the cavity when the cover is attached to the container. Such a handle structure is specifically set forth in the specification and drawings as originally filed (see Figs. 4, 5, and 7-10).

In contrast, as noted above, the Cortese reference is deficient as it does not include each and every element of the amended claims.

For the foregoing reasons, Applicant respectfully asserts that the amended claims overcome and are allowable over the rejection under 35 U.S.C. §102 based on Cortese. Applicant respectfully requests that the Examiner withdrawal the rejection and allow the claims.

Similarly, claims 11-13 and 15 have been rejected 35 U.S.C. §102 based on the Wai reference. Applicant respectfully asserts that the claims as amended herein overcome and are allowable over this rejection and respectfully requests favorable reconsideration of the present application in view of the amendments set forth herein, withdraw of the rejection, and allowance of these claims. It should be noted that claim 15 has been canceled in the present amendment and will not be discussed with regard to this rejection.

Applicant refers to the arguments with regard to the Cortese rejection as set forth herein above and asserts the arguments with regard to the Wai reference. While the Wai reference does include a handle, the handle is not contained within the cavity of the substance holder and as such is different than the claimed invention. As such, the Wai reference is deficient since it does not include each and every element of the amended claims.

For the foregoing reasons, Applicant respectfully asserts that the amended claims overcome and are allowable over the rejections under 35 U.S.C. §102 based on Wai. Application respectfully requests that the Examiner withdraw the rejections and allow the claims.

Rejections under 35 U.S.C. §103

With regard to the rejections under 35 U.S.C. §103, the rejections of the claims are primarily dependent on Cortese or, individually, Wai as the primary reference. As such, if each of these references fails to provide support for a rejection of the amended claims, the other reference, NL-1020835 (the "NL" reference) which has been applied in the 103 rejections, in combination with each of these references, separately, cannot provide the missing support.

The NL reference merely provides a filter structure and does not provide a handle structure as set forth in the amended claims. As such, the failure of the primary references (Cortese and Wai) to provide the primary support will result in failure of the 103 rejections since the NL reference does not overcome the deficiencies of the primary references.

Applicant refers to the arguments set forth above relating to the deficiencies of the Cortese and Wai references with regard to the rejection under 35 U.S.C. §102. While applicant is not arguing the same legal basis for the failure of the rejection under 35 U.S.C. §102, Applicant believes that all of the structural, functional, and technical discussion relating to the deficiencies of the Cortese and Wai references apply to the rejection under 35 U.S.C. §103.

Further, with regard to the rejections under 35 U.S.C. §103 (a), it is respectfully submitted that applicants claims are patentable, as the Examiner has failed to establish a *prima facie* case of obviousness. According to section 706.02 (j) of the MPEP the Examiner must meet three basic criteria to establish a *prima facie* case of obviousness:

- (1) first, there must be some reasonable suggestion or motivation in the prior art to modify the reference or to combine the reference teachings;
- (2) second, there must be reasonable expectation of success in obtaining the claimed invention based upon the references relied upon the Examiner; and
- (3) third, the prior art reference (or references when combined) must teach or suggest all of the claimed limitations.

MPEP Section 706.02(j) further requires that the teaching or suggestion to make the modification or reference combination and the expectation of success, must be found in the prior art, and may not be based upon the applicants disclosure.

Neither of the references provides any suggestion or motivation to combine to achieve the claimed invention. Rather, a combination of the two cited references either teaches away from the claimed invention or are redundant.

There is no reasonable expectation of success in obtaining the invention set forth in the amended claims based on the cited references. Neither reference provides a handle on a cover and retained within the cavity. The cited prior art references, relying primarily, separately on the Cortese and Wai references do not teach nor suggest all the claimed limitations.

Applicant respectfully asserts that the Cortese and Wai references, separately, fail as a primary references to support the rejections under 35 U.S.C. §103. Failure of these references results in failure of the rejection since there is no support for combination with the NL reference. The NL reference does not satisfy the missing limitations not found in Cortese or Wai. With the foregoing in mind, Applicant respectfully requests the Examiner to withdraw the rejections under 35 U.S.C. §103.

Furthermore, the amendments to the claims are fully supported by the specification and the drawings as originally filed and do not add any new matter. For the foregoing reasons, Applicant respectfully asserts that claims 3, 9, and 14 are in condition for allowance based on the amendments herein and as such, allowance is, respectfully requested. Favorable reconsideration of the claims as amended herein is respectfully requested.

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

U.S. Patent Application No. 10/599,777
Attorney Docket No. 27726-103081

Applicant herewith Petitions for an Extension of Time. It is requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response with the fee for such extensions and any other fees or shortages in other fees, being charged, or any overpayment in such fees being credited, to the Deposit Account of Barnes & Thornburg LLP, Deposit Account No. 12-0913 acknowledging attorney docket no. (27726-103081).

Respectfully submitted,

BARNES & THORNBURG LLP

A handwritten signature in black ink, appearing to read "Grant H. Peters", written over a horizontal line.

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